



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,780	07/26/2001	Harn-Jing Terng	12674-003001	6948

26161 7590 12/04/2002

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

TUNG, JOYCE

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/915,780

Applicant(s)
Terng et al.

Examiner
Joyce Tung

Art Unit
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) 10-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☒ Other: Notice to comply with sequence rules

Art Unit: 1637

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group I, claims 1-9 and 23-37 in Paper No. 5 is acknowledged.
2. Claims 10-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claims.

Double Patenting

3. Claims 3-5, 23, 26-28 and 30-31 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7-9, 29, 32-37. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1637

5. Claims 27-28 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 27-28 and 33 are vague and indefinite because the language “the first binding members of the first primers are different oligonucleotides” is unclear that the first binding members of the first primers are different oligonucleotides from what. Clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1637

7. Claims 1-2, 5-6, 9, 23-26, 28-29, 31-32, 34-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drazen et al. (6,156,503) in view of Drmanac et al. (6,383,742).

Drazen et al. disclose a method and kit of identifying individuals at risk for an adverse response to β -agonist therapy (See column 1, lines 51-54). The method involves using allelic specific primer which has the same structure as the structure of the claimed discrimination primer (See column 11, lines 12-26) except the primer of Drazen et al. does not comprise a binding member covalently bonded to the 5' end of the primer. The primer of Drazen et al. has a mismatch at penultimate position from the 3' end (See column 11, lines 17-26) and a segment of nucleotide located immediately 5' to the second base is complementary to a part of target nucleic acid (the nucleic acid) (See column 11, lines 17-26).

Drazen et al. do not disclose that the primer comprises a binding member of a specific binding pair covalently bonded to the 5' end of the primer.

Drmanac et al. disclose a method of detecting a target nucleic acid species involving using labeled probe (See the Abstract). The label can be ligands which can serve as specific binding members to a labeled antibody, chemiluminescers, enzymes, antibodies which can serve as a specific binding pair member for a labeled ligand (See column 18, lines 64-67 to column 19, lines 1-4). Drmanac et al. also disclose the use of CovaLink NH strips for covalent binding of DNA molecules at the 5' end (See column 22, lines 1-14).

Therefore one of ordinary skill in the art would have been motivated to modify the primer of Drazen et al. to apply the teachings of Drmanac et al. (See column 18, lines 64-67 to column

Art Unit: 1637

19, lines 1-4 and column 22, lines 1-14) for modifying the primer of Drazen et al. with a binding member of a specific binding pair covalently bonded to the 5' end of the segment as claimed with a reasonable expectations of success. The motivation is that by using the binding member of a specific binding pair at 5' end of the nucleic acid probe, a small number of nucleic acid sample can be fast identified (See column 6, lines 64-67). It would have been prima facie obvious to make the primer as claimed.

8. Claims 3-4, 7-8, 26, 30, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drazen et al. (6,156,503) in view of Drmanac et al. (6,383,742) as applied to claims 1-2, 5-6, 9, 23-26, 28-29, 31-32, 34-35 and 37 above, and further in view of Higuchi et al. (5,994,056).

The teachings of Drazen et al. and Drmanac et al. are set forth in section 8 above, and Drazen et al. and Drmanac et al. do not disclose a primer which comprises a non-complementary sequence to a target nucleic acid at 5' end.

Higuchi et al. disclose an improved method for nucleic acid detection via polymerase chain reaction (See the Abstract). Higuchi et al. also disclose a primer which have non-complementary sequence added to the 5' end. The "tails" are useful for engineering particular restriction sites or other purposes. It is useful for increasing signal strength in the presence of genomic DNA (See column 14, lines 32-47).

Thus, one of ordinary skill in the art at the time of the instant invention would have been motivated to modify the primer of Drazen et al. with a non-complementary sequence to a target

Art Unit: 1637

nucleic acid at 5' end because of the advantage of using the non-complementary sequence tail as taught by Higuchi et al. (See column 14, lines 32-47). Additionally, one of ordinary skill in the art would have made the non-complementary sequence tail with 10-40 nucleotides in length because the probes which have the length of 10-40 nucleotides provide a specific hybridization binding to a target sequence. It would have been prima facie obvious to make the primer as claimed.

Sequence Rules

9. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. **APPLICANT IS GIVEN THE RESPONSE PERIOD SET FORTH IN THIS OFFICE ACTION WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g).**

Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Art Unit: 1637

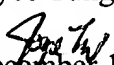
10. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

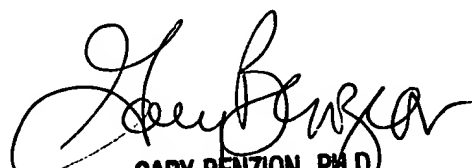
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung


December 1, 2002


GARY BENZION, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s)

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: _____

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE